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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,053	10/21/2003	Robert H. Folk II	D03085	3498
43471	7590	02/07/2008		
Motorola, Inc. Law Department 1303 East Algonquin Road 3rd Floor Schaumburg, IL 60196			EXAMINER POWERS, WILLIAM S	
			ART UNIT 2134	PAPER NUMBER
			NOTIFICATION DATE 02/07/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/690,053

Applicant(s)

FOLK, ROBERT H.

Examiner

William S. Powers

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/2007 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 11/21/2007 have been fully considered but they are not persuasive.

3. As to Applicant's arguments that Reese and Barton do not teach the newly added limitations "'determining whether the requested content resides in an encrypted form on the first hard disk recorder, wherein the encrypted form comprises encryption via a local encryption scheme' and 'determining whether the requested content resides in the encrypted form on a second hard disk recorder'" (Remarks, page 7, lines 1-9), the Examiner respectfully disagrees. Barton states, "the media content is decrypted only if it is viewed, thus protecting the content from theft. It is possible for the DVR to save these encrypted media

streams to disk, and initiate decryption upon playback” (Barton, paragraph [0085]). Clearly, the content in Barton can reside in encrypted form on the hard disk. Since the media is only decrypted for viewing purposes, only encrypted media content resides on the hard disk and if a requested media file is present on a hard disk, it would have to be in encrypted form. For at least the reasons above, the rejection to claim 1 is maintained.

4. As to Applicant’s argument that “Barton teaches away from determining whether the requested content already resides in an encrypted form on the either the first or second hard disk recorder” (Remarks, page 7, lines 9-12), the Examiner respectfully disagrees. Barton states, “the media content is decrypted only if it is viewed, thus protecting the content from theft. It is possible for the DVR to save these encrypted media streams to disk, and initiate decryption upon playback” (Barton, paragraph [0085]). Clearly, Barton teaches storing encrypted content on a hard disk. For at least the reasons above, the rejection to claim 1 is maintained.

5. The newly added claims are addressed below.

### ***Response to Amendment***

6. The Examiner has stated the below column and line numbers as examples. All columns and line numbers in the reference and the figures are relevant material and Applicant should be taken the entire reference into consideration upon the reply to this Office Action.

***Information Disclosure Statement***

7. No Information Disclosure Statements have been submitted with the application.

***Claim Objections***

8. Claims 11 and 12 are objected to because of the following informalities: the limitation "the content" seems to refer to "the re-encrypted requested content" of claim 10, but it is not definitive as presently stated. For purposes of examination, the Examiner assumes that "the content" refers to "the re-encrypted requested content" of claim 10. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant has provided no support from the specification for the amendment to claim 1 that includes the method step of "determining whether the requested content resides in an encrypted form on the first hard disk recorder" and "determining whether the requested content resides in the encrypted form on a second hard disk" (claim 1). The Examiner could find no support for the method step of determining the requested content is stored in encrypted form on any hard disk. Therefore, until the Applicant provides support for this amendment, the abovementioned amendment to claim 1 is considered new matter.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No. 2002/0141732 to Reese et al. (hereinafter Reese) in view of US Patent Application Publication No. 2003/0095791 to Barton et al. (hereinafter Barton).

As to claim 1, Reese teaches:

- a. Receiving a request to view content on a first hard disk recorder (Reese, paragraph [0021]).

Reese decodes video content (Reese, paragraph 12), but does not expressly mention the encryption schemes. However, in an analogous art, Barton teaches:

- b. Determining whether the requested content resides in an encrypted form on the first hard disk recorder, wherein the encrypted form comprises encryption via a local encryption scheme (Content is stored in encrypted form on a hard disk) (Barton, paragraph [0085]).

Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to implement the networked DVRs of Reese with the encryption scheme of Barton in order to protect video content from theft as suggested by Barton (Barton, paragraph [0085]).

Reese as modified further teaches:

- c. If the requested content does not reside on the first hard disk recorder, determining whether the requested content resides in the

encrypted form (Barton, paragraph [0085]) on a second hard disk recorder (A DVRC in the network of Reese can act as a master device and a slave device simultaneously. Thus, the master DVRC can issue a control signal to itself (Reese, paragraph [0020]), and display the selected video image whether it resides on the master DVRC or from other DVRs or DVRCs in the network.) (Reese, paragraph [0023]).

c. Decrypting the requested content via a local encryption scheme (Barton, paragraph [0080]).

d. Displaying the requested content on a display device coupled to the first hard disk recorder (Reese, paragraph [0020]).

As to claim 2, Reese as modified teaches storing the requested content within a memory located within the first hard disk recorder (Reese, paragraph [0013]).

As to claim 3, Reese as modified teaches remotely accessing the requested content on the first hard disk recorder (master DVR can remotely control the slave DVRs) (Reese, paragraph [0012]).

14. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No. 2002/0141732 to Reese et al. (hereinafter Reese) in view of US Patent Application Publication No.



2003/0095791 to Barton et al. (hereinafter Barton) as applied to claim 1 above, and further in view of US Patent Application Publication No. 2003/0051151 to Asano et al. (hereinafter Asano).

As to claim 10, Reese as modified teaches:

- a. Receiving the requested content on the first hard disk recorder from a content source (content downloaded from the service center over the internet) (Barton, paragraphs [0055-557]).

Reese as modified teaches the use of session keys and other cryptographic keys to secure communications between the DVR and the service center, but does not expressly mention decrypting content and re-encrypting the content. However, in an analogous art, Asano teaches:

- b. Decrypting the requested content utilizing a decryption key received from the content source (downloaded contents that are encrypted are decrypted) (Asano, paragraph [0015]).

Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to implement the networked DVRs of Reese as modified with the decryption and re-encryption of downloaded content of Asano in order to be able to use content according to the license granted to the apparatus as suggested by Asano (Asano, paragraph [0015]).

Reese as modified further teaches:

- c. Re-encrypting the requested content utilizing the local encryption scheme (re-encryption is done with apparatus's own key) (Asano, paragraph [0015]).
- d. Storing the re-encrypted requested content in a shared memory (Barton, paragraph [0085]).

As to claim 11, Reese as modified teaches storing the content in a shared memory located within the first hard disk recorder (Barton, paragraph [0085]).

As to claim 12, Reese as modified teaches storing the content in a shared memory located within the second hard disk recorder (content stored on portable DVR) (Barton, paragraph [0092]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William S. Powers whose telephone number is 751 272 8573. The examiner can normally be reached on m-f 7:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571 272 3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



1/31/2008

William S. Powers  
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Art Unit 2134



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